

Docket No.: 29618/39225B
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Timothy D. Killinger et al.

Application No.: 10/798,137

Filed: March 11, 2004

For: STORAGE CONTAINER HAVING DUAL
ACCESS

Confirmation No.: 5551

Art Unit: 3637

Examiner: James O. Hansen

PRE-APPEAL BRIEF REQUEST FOR REVIEW

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Applicants request review of the Final Office action in the above-identified application. No amendments are being filed with this request. This paper is timely filed in view of the petition for a one-month extension of time and fee submitted herewith. See M.P.E.P. § 706.07(f).

This paper is filed concurrently with a Notice of Appeal and fee, and includes no more than five pages of arguments for patentability. It follows a Final Office action dated July 2, 2007, and a response to the final action dated October 2, 2007. Reconsideration is respectfully requested in view of the following remarks.

Remarks begin on page 2 of the paper.

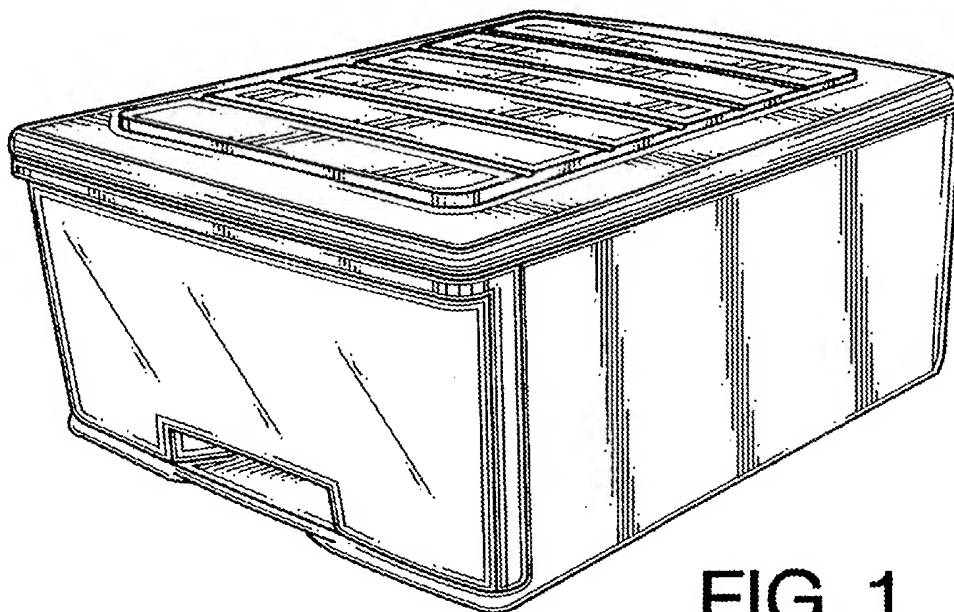
REMARKS

Claims 1-6, 11-16, 21, and 23-27 stand rejected as obvious over U.S. Design Patent No. D360,778 to Apt III et al. (“Apt”) in view of one or more of U.S. Design Patent Nos. D379,122 and D388,957 to Wolff (“Wolff”); and U.S. Patent No. 5,125,697 to Kahl et al. (“Kahl”).

The final rejection includes legal and factual deficiencies. In particular, the cited art fails to disclose or suggest each and every limitation recited in the pending claims. *See* the response to final action filed October 2, 2007, pages 8-9. Moreover, there is no motivation to combine the cited art references. *Id.*, pages 9-10. As a result, the pending claims cannot be rendered obvious over any combination of the cited art.

The office action improperly reads features into Apt

Apt discloses an ornamental design for a “storage drawer.” *See* Apt, title and page 1. Apt does not explicitly disclose or suggest that the “storage drawer” includes a lid of any sort. Yet, the office action asserts that Apt discloses a removable lid that is “readily apparent to the examiner.” *See* the official action, page 2. However, the office action provides no evidence to support this observation. The figures of Apt show an ornamental outer surface of a storage drawer. *See* Fig. 1 of Apt below:

**FIG. 1**

There is no way to tell from the figures whether the top surface of the Apt device is a lid or simply an integrated top portion of a frame. Moreover, the specification of Apt makes no reference to a lid whatsoever.

Apparently the office action is attempting to make an argument that Apt inherently discloses a removable lid, as the office action admits that Apt does not explicitly teach a lid of any sort. The inherent teaching of a prior art reference is a question of fact. *In re Napier*, 55 F.3d 610, 613, (Fed. Cir. 1995). “In relying on the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the alleged inherent characteristic necessarily flows from the teachings of the applied prior art.” Emphasis in the original, *see* M.P.E.P. § 2112(IV) citing *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990). Here, however, the office action provides no facts and no technical reasoning supporting the allegation that Apt inherently discloses a removable lid. There is no reasonable argument that a removable lid is necessary to the Apt device. To the contrary, the Apt device would function perfectly as an ornamental design for a “storage drawer” without a removable lid. Thus, a removable lid cannot be inherently disclosed by Apt. For this reason, the rejection of claims 1-6, 11-16, 21, and 23-27 is improper.

Conclusion

This paper is timely filed with a notice of appeal, a petition for a one month extension of time and the required fees. No other fees are believed due. However, the Director is hereby authorized to charge any fees which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 13-2855, under Order No. 29618/39225B.

October 30, 2007

Respectfully submitted,

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